1652

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February 27, 2003

Commissioner For Patents
Washington, D.C. 20231

Re: U.S. Patent Application No.: 09/885,294
Title: *METHODS FOR IMPROVING CELL GROWTH AND ALCOHOL PRODUCTION DURING FERMENTATION*
Inventor: Lonnie O. Ingram, *et al.*
Filed: June 19, 2001
Our Ref. No.: BCI-026

Dear Sir:

I enclose herewith for filing in the above-identified application the following:

1. Response to Restriction Requirement (3 pages);
2. Request for Five Month Extension of Time (1 page, *in duplicate*); and
2. A Return Postcard.

Please charge any necessary fees in connection with the enclosed statement to our Deposit Order Account No. 12-0080. For this purpose, a duplicate of this sheet is attached.

I hereby certify that this correspondence is deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on:

2/27/03
Date

Peter C. Lauro, Esq., Reg. No. 32,360

Respectfully submitted,
LAHIVE & COCKFIELD, LLP

Peter C. Lauro, Esq.
Registration No. 32,360
Attorney for Applicant

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Lonnie O. Ingram, *et al.*

Serial No.: 09/885,294

Filed: June 19, 2001

For: *METHODS FOR IMPROVING CELL GROWTH AND ALCOHOL PRODUCTION DURING FERMENTATION*

Attorney Docket No.: BCI-026

Group Art Unit: 1652

Examiner: Manjunath N. Rao

Commissioner for Patents
Washington, D.C. 20231

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2/27/03
Date of Signature and of Mail Deposit

By: Peter C. Lauro
Peter C. Lauro, Esq.
Reg. No. 32,360
Attorney for Applicants

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the restriction requirement set forth in the Office Action dated August 27, 2002 (Paper No. 5). A separate request for a five-month extension of time based on small entity status is submitted concurrently herewith.

The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

I. Claims 1, 3-42, drawn to a method for increasing alcohol production, classified in class 435, subclass 161.

II. Claims 2, 4-42 drawn to a method of increasing growth of a cell, classified in class 435, subclass 244.

III. Claims 43-47, 52, 54, drawn to a growth median, classified in class 435, subclass 253.6.

IV. Claims 48-51, 53, 55 drawn to a fermentation reaction mixture, classified in class 435, subclass 252.8.

Applicants are required to elect one of the above groups for prosecution on the merits.

Applicants respectfully traverse the requirements for restriction and election, and submit that the requirements are improper. First, Applicants assert that the subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences of a single invention, which merit examination of all of these claims in a single application. More particularly, a single, searchable, unifying aspect, *i.e.*, the compound of Formula I recited in each of the independent claims, links all of the claims.

Moreover, the patent statutes require that Applicants disclose how to make and use the compounds of the invention. It is only reasonable, then, that Applicants be allowed to prosecute the compounds and the methods for using the compounds in a single application. Therefore, it is improper to require that the subject matter of these groups be prosecuted in separate patent applications.

Second, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

> [i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P. § 803 (7th ed., Rel. 78A, March 1999).

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden.

Applicants submit that the search and examination of all the claims will have substantial overlap, and no serious burden will result from searching and examining all claims in the same application. This is especially true inasmuch as Groups I-IV are all classified in class 435. In view of this identity of classifications, and the data bases and powerful computer search engines available to the Examiner, there would be no serious burden in examining all the claims in a single application.

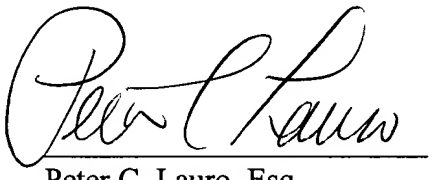
The Office Action, in the last full paragraph on page 2, indicates that the inventions are distinct because the "groups have acquired a separate status in the art and separate fields of search as further evidenced by their separate classification". However, this is nothing more than an unsupported conclusion, especially given that the Patent Office itself does not consider the inventions as having acquired a separate status in the art, given that the Office has classified all the claims in class 435.

Therefore, in the interest of savings of time and cost to Applicants and the Patent Office, Applicants respectfully request that all the claims be rejoined and searched and examined in a single application.

Nevertheless, in compliance with the directives in the Office Action and in order to expedite prosecution of the instant application, Applicants hereby elect, subject to the foregoing traverse, Group I (claims 1, 3-42).

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 227-7400.

Respectfully submitted,



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Dated: February 27, 2003